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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,472	08/20/2004	Stephen D. Gilder	5-41-56(16B)(4006-04202)	1706
26111 7590 12/09/2008 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER COONEY, JOHN M				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/505,472

Applicant(s)

GILDER ET AL.

Examiner

John Cooney

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,20-22,24-28,31-35,37 and 40-45 is/are pending in the application.
- 4a) Of the above claim(s) 31-35,37,40 and 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3-17,20-22,24-28,41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's arguments filed 9-5-08 have been fully considered but they are not persuasive.

Election/Restrictions

Applicant's election with traverse of Group I. in the reply filed on 9-5-08 is acknowledged. The traversal is on the ground(s) that all claims require the passing of the California 117 Burn test. This is not found persuasive because it is maintained that the special technical feature of performing the carbon dioxide frothing process and its carbon dioxide injection, filtering, and conveyance operations of the non-elected claims are not a part of or required by the invention of the elected group. That all claims may recite the passing of a particular fire test does not negate the distinction and lack of unity maintained to be evident.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims drawn to an invention nonelected with traverse in the reply filed on 9-5-08. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 31-35, 37, 40, and 43-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9-5-08.

Claim Rejection - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-17, 20-22, 24-28, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grace et al.(4,892,893), alone, or in view of Eiben et al.(5,789,457) and Webster et al.(3,862,921).

Grace et al. disclose methods for preparing polyurethane foams by mixing and reacting polyol, isocyanate, water, melamine, and other fire retardants under mixing conditions meeting those claimed (see column 2 line 22 - column 7 line 48 and the examples, as well as, the entire document).

Grace et al. differs from applicants' claims in that it does not particularly require filtering of its mixtures before of after passing through the mixing head. However, Eiben et al.(see abstract and claims) and Webster et al.(see column 6 lines 8-15) disclose employment of filter screens in polyurethane polymer processing operations for their filtration and other material enhancing effects. Accordingly, it would have been obvious

for one having ordinary skill in the art to have employed filters as disclosed by Eiben et al. and Webster et al. before and after ejection of the materials from the mixing head in the preparations of Grace et al. for the purpose of imparting their known filtration and materials enhancing effects in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Further, it is held that cleaning/scraping of filters, as set forth by applicants' new claim 43, for the purpose of maintaining their filtering efficiency and effectiveness, and to prevent blocking is a processing feature which would have been well within the skill of the ordinary practitioner in the art. Additionally, as for Grace et al.'s removal of polyol filters in its processes (column 7 lines 24-32), it is held that all disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. In re Mills, 176 USPQ; In re Lamberti, 192 USPQ 278; In re Boe, 148 USPQ 507.

Grace et al. differs from applicants' claims in that it does not specifically require its melamine to have the size and amount specifications as claimed by applicants. However, Grace et al. does recite control of its melamine particle sizes and amounts for the purpose of maintaining system stability and satisfactory product formation (see column 6 line 39 - column 7 line 32). Accordingly, it would have been obvious for one having ordinary skill in the art to have varied the amounts and sizes of the melamine particles employed within the teachings of Grace et al. for the purpose of maintaining system stability and satisfactory product formation within the preparations of Grace et al. in order to arrive at the products of applicants' claims with the expectation of success

in the absence of a showing of new or unexpected results. Also, regarding variations in amounts and sizes of this component, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of the same properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). Further, it is held here also that all disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. *In re Mills*, 176 USPQ; *In re Lamberti*, 192 USPQ 278; *In re Boe*, 148 USPQ 507.

Applicants' arguments have been considered. However, rejection is maintained for the reasons set forth in the rejection above.

Examiner maintains that the position of obviousness over Grace et al. alone or in combination with the teachings provided is properly set forth. The secondary teaching address the deficiencies indicated in the rejection above, and applicants' have not established the combinations to be improper, nor has a showing of new or unexpected results that is commensurate in scope with the scope of the claims sufficient to overcome the rejection been made.

Applicants' recent arguments pertaining to this rejection received 3-3-08 have been considered.

It is initially noted that applicants' claimed ranges of particles size values for their products and processes are of little value in distinguishing the claims because at least claims 1, 3-4, 6-8, 14-17, 20, 21, and 41 do not even require the presence of melamine. Further, it is seen that the claims only require that melamine be present in an amount of less than about ten percent, which is in overlap with the ranges of values provided for by Grace et al. (see again column 2 lines 29-30). The additional recitations of the claims pertaining to melamine, with "is" being seen to be equivalent to "comprising", are seen to only be further defining a feature of the melamine component, if it is even present, and it is not seen to be further narrowing of the claims limitations pertaining to the content of melamine. Particularly, the claims as they stand are only seen to be limited to melamine being in an amount of less than about 10 weight percent in any form and that some portion of that melamine, if melamine is present, have the size and make-up identified by applicants' claims.

Beyond this above holding, it is held and maintained that Grace et al. provides for control in the particle size distribution and amounts of employment for purposes of achieving stable systems for acceptable product formation to such a degree that arrival at the melamine component requirements of applicants' claims from within the teachings of Grace et al. would have been within the purview of the ordinary practitioner in the art. Examiner maintains the position of obviousness to be proper in regards to this feature of applicants' claims.

Even applicants' process claims are not seen to distinguish over the combined prior art based on the melamine component parameters because it is maintained to be evident that Grace et al. provides for adequate control of the size and amount of melamine sufficient to arrive at this feature of applicants' claims.

Reference to the process as being a "slabstock" process in the preamble of applicants' claims is not seen to be distinguishing of the claims in the patentable sense. The full teachings of the combined prior art pertain to forming flexible polyurethane foam articles through application of the materials to molds and/or formation of slabs through release onto conveyor belts. Without distinction being identified in specific processing features recited in the claims, distinction based on the process being identified as a "slabstock" process in the preamble is not seen.

Applicants' arguments pertaining to withdrawn claims are unpersuasive of patentability for the claims that have been elected as they relate to features not contained in the claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796

Application Number**Application/Control No.**

10/505,472

Examiner

John Cooney

**Applicant(s)/Patent under
Reexamination**

GILDER ET AL.

Art Unit

1796